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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/625,325	07/23/2003	Douglas G. Guenther	WT0115	7745

7590
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Wilson Sporting Goods Co.
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06/12/2007

EXAMINER

WONG, STEVEN B

ART UNIT	PAPER NUMBER
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3711

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/625,325

Applicant(s)

GUENTHER ET AL.

Examiner

/Steven Wong/

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 51-64 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 51-64 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 103

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 1-3, 5, 7, 9, 10 and 51-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horkan (5,570,882) in view of Martin (4,570,931). Regarding claim 1, Horkan discloses a football construction including laces that have hook or loop fasteners thereon for improving the gripping of the ball. Note column 2, lines 51 and 52 stating that the fastener merely replaces the conventional lacing.

Martin discloses that it is well known in the art of game balls to provide projections on the surface of the ball in order to improve its grippability. It would have been obvious to one of ordinary skill in the art to replace the hook fastener as taught by Horkan with a plurality of projections in order to provide an alternative textured surface that also improves the gripping of the football and does not rely on the use of the glove. Further, the combination of Horkan in view of Martin would teach a highly grippable surface for the laces. The ball of Horkan in view of Martin is obviously capable of being used in competitive play and being grasped by the hand of a user. Horkan particularly teaches that the laces of the ball are enhanced in order to improve grasping thereof by the hand of the user. Further, the projections of Martin when placed on the laces will obviously be projecting outwardly from the football.

Regarding claims 2 and 3, the projections of Martin are described as pebbles.

Regarding claims 5 and 7, Martin teaches arranging equal sized pebbles in an evenly spaced pattern. It would have been obvious to one of ordinary skill in the art to place the equal

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sized pebbles in an evenly spaced pattern on the laces in order to provide an aesthetically pleasing design for the ball.

Regarding claims 9 and 10, note Figure 9 of Martin showing the height and width for the projections. The claimed aspect ratio is considered to be obvious given the teachings of Martin and the lack of a showing of the criticality for the claimed aspect ratio by a new and unexpected result obtained therefrom.

Regarding claims 51-64, note column 3, lines 12-17 of Martin stating that other shapes may also be used as projections. It would have been obvious to one of ordinary skill in the art to provide the laces of Horkan with the shapes taught by Martin order to provide an alternative textured surface that also improves the gripping of the football and does not rely on the use of the glove. Further, any other shapes claimed by applicant and not disclosed by Martin (oval, irregular) are considered to be obvious given the teachings of Martin and the lack of a showing of the criticality for the claimed shapes by a new and unexpected result obtained therefrom.

3. Claims 4, 8, 11, 12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horkan (5,570,882) in view of Martin (4,570,931) and Feeney (6,283,881). Regarding claim 4, Feeney discloses a game ball construction including a plurality of differently shaped projections on the surface of the ball (note Figure 8 and column 5, lines 16-30). It would have been obvious to one of ordinary skill in the art to provide differently shaped projections on the laces of the ball of Horkan as modified by Martin in order to arrange a particular design for the ball while still improving the grip.

Regarding claim 8, the projections of Feeney are of varying sizes.

Regarding claim 11, Horkan teaches lacing that provides a plurality of longitudinally extending segments and a plurality of transversely extending segments. It would have been obvious to one of ordinary skill in the art to apply a first shaped projection to the longitudinal segments and a second shape to the transverse segments as the applicant has not disclosed that this particular arrangement is for any particular purpose or solves any stated problem and it appears that the arrangement of Horkan as modified by Martin and Feeney would accomplish similar purposes.

Regarding claim 12, Horkan teaches hook fasteners along the entire surface of the lacing. To replace the hook fasteners with the projections of Martin would obviously also place projections along the entire surface of the lacing.

Regarding claim 14, it would have been obvious to one of ordinary skill in the art to form the lacing of Horkan from a polyurethane material in order to take advantage of that material's well known physical properties.

4. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Horkan (6,629,902) in view of Martin (4,570,931) and Finley (4,991,842). Finley reveals a grip enhanced basketball where the projections are randomly placed. It would have been obvious to one of ordinary skill in the art to randomly place the projections on the laces of the ball of Horkan as modified by Martin in order to provide a particular design pattern for the laces.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined

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application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-14 and 51-64 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 51 and 53-65 of copending Application No. 11/018,628. Although the conflicting claims are not identical, they are not patentably distinct from each other because the projections of 11/018,628 define the pebbled texture as set forth in the instant application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

7. Applicant's arguments filed April 13, 2007 have been fully considered but they are not persuasive. Regarding the rejection under 35 U.S.C. 103(a) of the claimed invention over Horkan in view of Martin, the applicant argues that Horkan is directed to a football having laces and a glove with hook and loop fasteners thereon. The applicant states that Horkan does not teach or suggest improving the grip of the ball without the use of the glove. Further, the applicant argues that Horkan implies that only the laces are to include the improved gripping surface and that the rest of the ball must be more slippery and less grippable than the hook and

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loop material. The applicant then contends that Martin is directed to a basketball with pebbles on its entire outer surface. The applicant argues that there is no suggestion to modify the laces of the football of Horkan which are in one specific location with the pebbles of Martin which are located over the entire surface of a basketball.

However, these arguments are not persuasive as the combination of Horkan in view of Martin is still seen as being properly combined and teaching the instant invention. Horkan provides a football construction where the laces are modified in order to improve the gripping ability of the ball. Note column 1, lines 62-67 of Horkan stating that the objectives of the invention are to properly impart spin to a thrown football and improve the user's grasping and controlling of the football. Clearly, these objectives would suggest to one of ordinary skill in the art to look at other arrangements for the laces that also would improve the gripping and controlling of the football by improving the gripping of the laces. The reference to Martin provides such a solution by teaching pebble-like projections on the surface of a basketball that improve its gripping and controlling. Note column 1, lines 18-25 and column 2, lines 30-36 of Martin. These passages disclose that the pebble-like projections improve the gripping of the ball. Thus, contrary to applicant's argument, the reference to Horkan provides a suggestion to modify the laces with the hook/loop fasteners thereon with alternative arrangements that would also improve the gripping and controlling of the football. Martin provides a solution to the suggestion by providing pebble-like projections that are taught as improving the gripping of the basketball.

Regarding Horkan's placement of the loop elements at only the fingertips of the matching glove, this teaching is not seen as teaching away from the combination of Horkan in view of

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Martin. The placement of the loop elements at only the fingertips of the glove is commensurate with the teachings of Martin as it is well known in the art that it is the user's fingertips which engage the laces of the football for throwing purposes. Just like the engagement between the hook elements on the laces and the loop elements on the fingertips in the invention of Horkan provides a positive feedback so would the engagement between pebbles on the laces and the user's fingertips in the combination of Horkan in view of Martin. The applicant also argues that without the interaction between the loop and hook elements nothing would urge the user's hands into the proper grasping of the laces. However, this argument is also not persuasive as it is the positive feedback and grasping ability thereof that would occur between the pebbled laces and the user's fingertips that would urge the user's hands into the proper grasping of the laces.

Regarding the applicant's argument that Horkan provides a strong connection between the laces and glove that would not be recreated by the pebble-like projections on the laces, even if this true, it is not seen as precluding the replacement of the hook and loop fasteners with just the pebble-like projections. Replacement of the fasteners with the projections would still accomplish the stated objectives of both references and would provide other advantageous aspects not obtained by the hook and loop fasteners such as the elimination of the glove and the direct grasping of the football on the laces by the user's hand.

In the remarks filed April 13, 2007, the applicant also argues that the examiner implies that the objective of Horkan is to modify the laces of the football in order to generally improve the gripping ability of the ball, including the ability to impart spin to a thrown football and to improve the user's grasping and controlling of the football. The applicant disagrees with this characterization of Horkan. The applicant argues that Horkan specifically defines his training

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aid as a modified football and glove combination. The applicant also states that Horkan is very specific to the glove and football combination and to improving the grasp of a football correctly. The applicant states that one of ordinary skill in the art would not look at other arrangements for the laces because Horkan specifically requires hook and loop fasteners to accomplish his objective.

However, these arguments are not persuasive as the reference to Horkan is still seen as a suggestion to one of ordinary skill in the art to modify the laces of a football in order to improve the throwing and grasping of the football. While Horkan specifically teaches a combination of the hook and loop fasteners in order to accomplish this objective, Horkan is clear in stating that providing the increased frictional contact between the fingers and the laces improves the grasping and throwing of the football. Further, the combination of the glove and laces of Horkan provides a suggestion to one of ordinary skill in the art to look at other arrangements for the laces that would also improve the frictional contact between the laces and the user's grip. Martin teaches that it is well known in the art of sports balls to provide pebble-like projections on the surface of a sports ball in order to improve its gripping and controlling. Given the suggestion of Horkan to improve the frictional contact between the laces and the user's grip, it would have been obvious to one of ordinary skill in the art to replace the hook and loop fasteners with simply pebble-like projections on the laces in order to improve the grip and control of the ball.

Regarding the applicant's argument that the combination of Horkan in view of Martin would not accomplish the objectives of Horkan, such is not seen. By applying the pebbles of Martin to the laces of a football, the laces would inherently improve the grip of the football of the user. By improving the grip of the football, the user would therefore be more able to impart a

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spin to the thrown football. Further, the application of the pebbles of Martin to the laces of a football is also seen as urging the users fingertips into proper engagement with the laces of the football as he would receive tactile feedback when his fingertips contact the pebbles on the laces.

Regarding the applicant's argument that Horkan consistently teaches that it is the combination of the glove and laces of Horkan which provide the training aid, the applicant is requested to note that it is the combination of references to Horkan and Martin that is relied upon for teaching the claimed invention. The reference to Horkan provides a suggestion to one of ordinary skill in the art to modify the laces of a football in order to improve the gripping and throwing of the ball. The reference teaches to Martin teaches that it is already well known in the art of sports balls to modify the smooth surface of a ball by providing pebble-like projections thereon in order to also increase the gripping and controlling of the ball. Given these two teachings it would have been obvious to one of ordinary skill in the art to provide a football with pebble-like projections on the laces in order to improve the gripping and controlling of the ball.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the

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applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Regarding the combination of Horkan in view of Martin and Feeney, the reference to Feeney is relied upon merely for its teaching that it is well known in the art of game balls to provide projections of various shapes.

Regarding the combination of Horkan in view of Martin and Finley, the reference to Finley is relied upon merely for its teaching that it is well known in the art of game balls to randomly place projections on the surface of the ball. The references to Horkan and Martin teach the recited elements of claim 51.

Conclusion

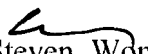
8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to /Steven Wong/ whose telephone number is 571-272-4416. The examiner can normally be reached on Monday through Friday 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Kim can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


/Steven Wong/
Primary Examiner
Art Unit 3711

SBW
May 30, 2007